

## **REMARKS:**

Claims 1-28 are currently pending in the application.

Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,460,038 to Khan *et al.* ("*Khan*").

Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over Khan in view of U.S. Patent No. 5,931,900 to Notani *et al.* ("*Notani*").

By this Amendment, independent Claims 1, 11, and 20 and dependent Claim 5 have been amended in order to expedite prosecution of the present application and to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

## **REJECTION UNDER 35 U.S.C. § 112:**

Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Specifically, the Final Office Action alleges that independent Claims 1, 11, 20 are indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention because it is allegedly not clear what is meant by each seller database being distinct in the distributed plurality of seller databases. (14 September 2006 Final Office Action, Page 13). The Applicants respectfully disagree. Nonetheless, in order to expedite prosecution of the present application, the Applicants have amended independent Claims 1, 11, and 20 to state "different" rather the distinct.

Support for this amendment may be found in numerous places within the Specification, including page 12, lines 10-14 and page 23, lines 15-26. The Applicants respectfully submit that the amendments to independent Claims 1, 11, and 20 are not necessitated by any prior art and is unrelated to the patentability of the present invention.

The Applicants have also amended dependent Claim 5 to correct the admitted language in the previous response. Therefore, the phrase "different hierarchies" has been added to dependent Claim 5. Support for this amendment may be found in numerous places within the Specification, including page 12, line 25 – page 13, line 9.

The Applicants respectfully submit that Claims 1, 5, 11, and 20 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that Claims 1, 5, 11, and 20 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1, 5, 11, and 20 under 35 U.S.C. § 112 be reconsidered and that Claims 1, 5, 11, and 20 be allowed.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over *Khan* over the Examiner's Official Notice. Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over *Khan* in view of *Notani*.

Although the Applicants believe Claims 1-28 are directed to patentable subject matter without amendment, the Applicants have amended independent Claims 1, 11, and 20 and dependent Claims 5, 7-10, 16-19, and 25-28 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Final Office Action.

The Applicants respectfully submit that *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 1-28. Thus, the Applicants respectfully traverse the Examiners

obvious rejection of Claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination.

**The Proposed *Khan*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent Claim 1, this claim recites:

An electronic commerce system for facilitating an electronic commerce transaction, the electronic commerce system comprising:

a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases, each seller database associated with a corresponding seller and different from other seller databases in the distributed plurality of seller databases, the global content directory comprising:

***a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;***

one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases; and

a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class, each seller database associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases;

a selection of a product class received from one of the plurality of buyers; and

***in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class.*** (Emphasis Added).

Amended independent Claims 11 and 20 recite similar limitations. *Khan* or the Examiner's Official Notice either individually or in combination, fail to disclose each and every limitation of independent Claims 1, 11, and 20.

The Applicants respectfully submit that *Khan* does not disclose, teach, or suggest amended independent Claim 1 limitations regarding “***in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class.***” Specifically, the Final Office Action points to elements 402, 502, and 602 of Figures 4, 5, and 6 of *Khan* as teaching “***in response to the selection of the product class received from one of the plurality of buyers.***” However, elements 402, 502, and 602 of Figures 4, 5, and 6 of *Khan* do not teach the “***in response to the selection of the product class received from one of the plurality of buyers***”, as recited in amended independent Claim 1. Instead, element 402 teaches that a user is asked a particular date and time to be reminded to visit a website linked to the selected bookmark. In addition, the user, in *Khan*, is not asked anything about a product and the user’s response has nothing to do with a product or the user making a product selection from a global content directory. Rather, the user, in *Khan*, is merely reminded to visit a particular website in the future.

Element 502 teaches that a user is queried as to whether the user would like to be notified of updates to the website and a time interval for receiving updates for the website. Again, the query issued to the user, in *Khan*, ***has nothing do with any product***, but rather the query is merely provided for being notified of an update to the website. These updates, regardless of what the update contains, are sent to the user and are ***not tied to a product; rather they are tied to the website***. Thus, the updates or generating the updates are not equivalent to a user making a product selection from a global content directory. Element 602 teaches a “pulled update” feature, wherein a user is asked for keywords related to website. When the keyword is detected on the website, the user, in *Khan*, is notified that the word now appears on the webpage. Thus, the updates or generating the updates are not equivalent to a user making a product selection from a global content directory. Therefore, for at least the reasons set forth above, *Khan* does not teach, suggest, or even hint at “***in response to the selection of the product class received from one of the plurality of buyers,***” as recited in amended independent Claim 1.

Furthermore, looking at Figure 3 of *Khan*, elements 402, 502, and 602 are performed when a bookmark is created. The bookmark, in *Khan*, is merely a link to a website. However, the limitations of amended independent Claim 1 recite ***“in response to the selection of the product class received from one of the plurality of buyers.”*** In contrast, a website is not a product class. In addition, creating a bookmark to a website, in *Khan*, is not the same as a user selecting a product class from the global content directory. Thus, even if any of elements 402, 502, or 602 could somehow be construed as buyer queries, which they are not, they are clearly not, elements 402, 502, or 602 do not teach, suggest, or even hint at a selection of product class as they are performed in response to the creation of a bookmark, or link, to a website. Thus, as elements 402, 502, or 602 are performed in response to the creation of a bookmark, or link, to a website, it follows that elements 402, 502, or 602 cannot be equivalent to the selection of a product class (from the global content directory) from one of the plurality of users. Therefore, for at least the reasons set forth above, *Khan* does not teach, suggest, or even hint at ***“in response to the selection of the product class received from one of the plurality of buyers,”*** as recited in amended independent Claim 1.

Additionally, the Final Office Action States that Figure 10 teaches ***“communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,”*** as Figure 10 allegedly teaches showing the results of a search query for product data, such as cargo pants and a special fare, and therefore a query must have been communicated. The Applicants respectfully disagree. Figure 10 neither teaches ***“communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,”*** nor the results of a search query for product data. As shown in Figure 10, the cargo pants notification and special fares notification are displayed as part of the “service delivery feature”. This feature is explained in greater detail in column 13, line 23 – column 14, line 7 and Figure 9. As taught by *Khan*, according to this service, a user is queried as to whether the user wants to receive sales and marketing information from the website. If so, the user, in *Khan*, is automatically of any and all such information. Thus the notification or result displayed in Figure 10 is due to the user signing up to receive marketing and sales updates for the entire website.

Khan does not teach, suggest, or even hint at an indication that the marketing and sales data is restricted to a specific selected product class, as recited in amended independent Claim 1. Thus, the information regarding cargo pants and special fares displayed in Figure 10 is not a search result for product data for a selected product class.

Furthermore, while the Final Office Action separates the feature of ***“in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,”*** into two parts in order to teach the limitation, none of the passage cited by the Final Office Action disclose, teach, or suggest communicating a search query for product data in response to the selection of the of the product class (form the global content directory) by a buyer. Rather, the Final Office Action seems to cite to passages that allegedly teach a buyer making a product query and a passage that allegedly show shows results from a query. Applicants respectfully disagree with the Final Office Action and have argued that none of the cited passages disclose, teach, or suggest a buyer making a query about product due to the selection of the product or displaying results of a communicated product query. However, even the passages cited by the Final Office Action are assumed to teach a buyer generating a query and the results of a query being shown, nowhere is it shown that a product query for product data is sent to a seller database in response to a selection of the that product by the buyer from the global content directory.

The Applicants further respectfully submit that *Khan* does not disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class.”*** The Final Office Action states that *Khan* teaches a global content directory even though it does not use this term as labels are functionally related to the substrate of the article of manufacture and that labels themselves carry little or no patentable weight. Through-out the Final Office Action, directory headers such as “shopping,” “travel,” and “finance” as being allegedly equivalent to the term “product class,” as used in amended independent Claim 1 of the

present application. Figure 10 does show these terms (i.e. “shopping,” “travel,” and “finance”) arranged in a directory in hierarchical order. However, ***merely arranging words in a directory in hierarchical order does not make them equivalent to the term product class***, as recited in amended independent Claim 1. Instead, amended independent Claim 1 provides ***“each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***. *Khan* fails to disclose, teach, or suggest ***“each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***, as recited in amended independent Claim 1.

As shown in Figure 10 of *Khan*, the category “Shopping” has list of bookmarks, which are links to a websites; for the websites LL Bean, Gap, and LandsEnd. The Applicants are unaware of how “shopping” is a product or product class and how “shopping” categorizes a plurality of products and defines one or more attributes of the products categorized in the product class. Furthermore, how is LL Bean, Gap, and LandsEnd a “product?” The Final Office Action states, numerous times, that these are “sellers.” (14 September 2006 Final Office Action, Pages 12, 14-17). Also, on page 6, the Final Office Action states that bookmarks are pointers. And, on page 7, the Final Office Action states that the URLs are pointers that are associated with the product class. Thus, at best, the directory structure taught by *Khan* and illustrated in Figure 10 of *Khan* shows a set of pointers arranged in certain categories, ***but does not include or is not even related to a “directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***. Thus, for at least the reasons set forth above, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Khan* and amended independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Khan*.

The Applicants still further respectfully submit that the Examiner's Official Notice fails to cure the acknowledged deficiencies in *Khan*. The Examiner's Official Notice fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding "***in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,***" and "***a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class.***" Therefore, for at least the reasons set forth above, the Applicants respectfully submit that *Khan* or the Examiner's Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every limitation recited in amended independent Claim 1.

**The Proposed *Khan-Notani* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 2, 12, and 21.**

The Applicants respectfully submit that *Khan* or *Notani*, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent Claims 2, 12, and 21. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent Claims 2, 12, and 21 under 35 U.S.C. § 103(a) over the proposed combination of *Khan* and *Notani*, either individually or in combination.

Claims 2, 12, and 21 depend from independent Claims 1, 11, and 20, respectively. As argued above with respect to amended independent Claim 1, *Khan* fails to disclose, teach, or suggest all the limitations of amended independent Claim 1. *Notani* fails to cure the acknowledged deficiencies of *Khan*. *Notani* fails to disclose, teach, or suggest the amended independent Claim 1 limitations including "***in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,***" and "***a directory structure comprising a plurality of product classes organized in a hierarchy, each product***



***class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class***". In addition, the Final Office Action fails to cite to any portion of *Notani* as teaching the limitations recited in amended independent Claim 1. Thus, dependent Claims 2, 12, and 21 are considered patentably distinguishable over the combination of *Khan* and *Notani*.

**The Applicants Claims are Patentable over the Proposed *Khan*-Official-Notice-*Notani* Combination**

The Applicants respectfully submit that amended independent Claims 11 and 20 include limitations similar to those discussed above in connection with amended independent Claim 1. Thus, amended independent Claims 11 and 20 are considered patentably distinguishable over *Khan*, *Notani*, or the Examiners Official Notice for at least the reasons discussed above in connection with amended independent Claim 1.

With respect to dependent Claims 2-10, 12-19, and 21-28: Claims 2-10 depend from amended independent Claim 1; Claims 12-19 depend from amended independent Claim 11; and Claims 21-28 depend from amended independent Claim 20. As mentioned above, each of amended independent Claims 1, 11, and 20 are considered patentably distinguishable over the proposed combination of *Khan*, *Notani*, and the Examiner's Official Notice. Thus, dependent Claims 2-10, 12-19, and 21-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that Claims 1-28 are not rendered obvious by the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice. The Applicants further respectfully submit that Claims 1-28 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-28 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-28 be allowed.

**THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references***

***themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding

common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

11/10/06  
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